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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,792	06/27/2003	Anne O'Malley	50655.1500	6883
66170 7590 09/30/2010 Snell & Wilmer L.L.P. (AMEX) ONE ARIZONA CENTER 400 E. VAN BUREN STREET PHOENIX, AZ 85004-2202				
EXAMINER NGUYEN, HIEP VAN				
ART UNIT 3686		PAPER NUMBER		
NOTIFICATION DATE 09/30/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

HSOBELMAN@SWLAW.COM

DMIER@SWLAW.COM

JESLICK@SWLAW.COM

### Office Action Summary

**Application No.**

10/608,792

**Applicant(s)**

O'MALLEY ET AL.

**Examiner**

HIEP NGUYEN

**Art Unit**

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status*

1. Claims 1-25 have been examined.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "notifies said user of a third supplier system and requests additional user data in response to enrollment of said third supplier system in said enrollment system" is unclear. Claim 1 provides for the use of *a third supplier system*, but, since the claim does not set forth any steps involved in the function for this third system, it is unclear *what a third system* applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 2-11 are rejected as each depends from claim 1.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (US. 6,014,644) in view of Walker et al. (US. 5,945,653), and further in view of Zalewski et al. (US. 6,771,981).

5. With respect to Claim 1, Erickson teaches a system for membership enrollment comprising:

- a. an enrollment system including an enrollment system server for processing data in connection with a user ('644; Col. 7, lines 6-43);
- b. a first supplier system for providing a first membership indicia to said enrollment system in response to said user data provided for enrollment in a first membership program ('644; Col. 7, lines 44-67, Fig 1; Col. 8, lines 51-66; Fig 2);
- c. a second supplier system for providing a second membership indicia to said enrollment system in response to said user data provided for enrollment in a second membership program, said second membership indicia different from said first membership indicia ('644; Fig 1, Col. 7, lines 44-67; Col. 8, lines 51-66; Fig 2)

Erickson does not disclose clearly:

- d. a readable storage device including a database for storing said first and second membership indicia, and said user data;
- e. an enrollment system reader in communication with said readable storage device and said enrollment system server, said reader receiving said user data; wherein said enrollment system reader notifies said user of a third supplier system and requests additional user data in response to enrollment of said third supplier system in said enrollment system

However, Walker et al. discloses a readable storage device including a database for storing said first and second membership indicia, and said user data; and an enrollment system reader in communication with said readable storage device and said enrollment system server, said reader receiving said user data ('653; Fig 4; Col. 12, lines 25-55; Col./line 13/49-14/41.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the multiple broadcast data objects and response tracking of Erickson ('644; Abstract) the use of a readable storage device (credit card) at point of sale (reader) as taught by Walker et al. ('653; Abstract) for providing membership enrollment as described in the invention.

Erickson further discloses said enrollment system notifies said user of a third supplier system and requests additional user data in response to enrollment of said third

supplier system in said enrollment system ('644; Abstract; Col. 8, lines 28-50; Col. 9, lines 28-49)

However, the combined art does not disclose the reader. Zalewski disclose this feature using RFID ('981; Col. 9, lines 20-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the multiple broadcast data objects and response tracking of Erickson ('644; Abstract) the use of a readable storage device (credit card) at point of sale (reader) as taught by Walker et al. ('653; Abstract) and the use of RFID in Zalewski for providing membership enrollment as described in the invention.

Claims 12 is rejected as the same reason with Claim 1.

6. With respect to Claim 2, the combined art teaches the system according to claim 1. Walker et al. discloses wherein said reader is in communication with said enrollment system for providing said user data to said first and second suppliers ('653; Col. 18, lines 16-22 ).

Claim 13 is rejected as the same reason with Claim 2.

7. With respect to Claim 3, the combined art teaches the system according to claim 1. Walker et al. discloses wherein said enrollment system server provides said first and second membership indicia to said readable storage device, said readable storage device storing said first and second membership indicia in said readable storage device database ('653; Col./line 15/51-16/67).

Claim 14 is rejected as the same reason with Claim 3.

8. With respect to Claim 4, the combined art teaches the system according to claim 3. Walker et al. discloses wherein said readable storage device database further includes a rewards data file for storing rewards value ('653; Col. 14, lines 24-41).

Claim 15 is rejected as the same reason with Claim 4.

9. With respect to Claim 5, the combined art teaches a system according to claim 4. Zalewski et al. discloses further including a first supplier reader and a second supplier reader, said first and second supplier readers in communication with said enrollment system, said first and second supplier readers for providing said interrogation signal and receiving at least one of said first and second membership indicia ('981; Col. /line 10/39-11/3).

10. With respect to Claim 6, the combined art teaches the system according to claim 5. Walker et al. discloses wherein at least one of said first and second supplier systems provides value to said rewards data file ('653; Col 15, lines 37-50).

Claim 16 is rejected as the same reason with Claim 6.

11. With respect to Claims 7 and 8, the combined art teaches the system according to claim 6. Walker et al. discloses wherein said value is provided in accordance with said user data, and wherein said value is provided in response to receipt of said user data ('653; Col. 16, lines 10-43).

Claim 17 is rejected as the same reason with Claims 7 and 8.

12. With respect to Claim 9, the combined art teaches the system according to claim 3. Walker et al. discloses wherein said readable storage device stores said first membership indicia prior to storing said second membership indicia ('653; Fig 4).

Claim 18 is rejected as the same reason with Claim 9.



13. With respect to Claim 10, the combined art teaches the system according to claim 3. Walker et al. discloses wherein said readable storage device stores said first and second membership indicia substantially simultaneously ('653; Fig. 4).

Claim 19 is rejected as the same reason with Claim 10.

14. With respect to Claim 11, the combined art teaches the system according to claim 3. Walker et al. discloses wherein said readable storage device stores at least one of said first and second membership indicia automatically ('653; Col. 12, lines 26-55).

Claim 20 is rejected as the same reason with Claim 11.

15. Claim 21 is rejected as the same reason with Claim 1.

16. With respect to Claim 22, the combined art teaches the method according to claim 21:

Walker et al. discloses further comprising:

receiving at least one of the unique membership numbers from the storage device upon presentation of the device to a first service provider, the unique membership number identifying the user as a member of a first service provider membership program and

authenticating authenticity of at least the membership number and user ('653; Fig 4; Col. /line 13/49-14/8);

providing rewards points to the storage device in accordance with at least one of the unique membership number and a transaction indicia; and providing means for storing the rewards points for later redemption ('653; Col. 16, lines 10-43).

Claim 24 is rejected as the same reason with claim 21.

17. Claim 23 is rejected as the same reason with claim 12.

18. With respect to Claim 25, the combined art teaches a method according to 24. Zalewski et al. discloses wherein the transfer of at least one of said rewards points, user specific data, and unique membership number is via RF ('981; Col. 12, lines 1-8).

### ***Response to Amendment/Arguments***

19. Applicant's arguments filed 07/12/2010 have been fully considered but they are not persuasive.

20. In the Remark filed 07/12/2010, the Applicant argued that the combined art does not disclose an enrollment system including an enrollment system server for processing user data in connection with a user..., wherein said enrollment system reader notifies

said user of a third supplier system and requests additional user data in response to enrollment of said third supplier system in said enrollment system" as amended in independent claim 1, nor membership indicia; and an RFID reader in communication with said RFID storage device and said enrollment system server, said RFID reader for providing said interrogation signal, receiving said user data, and providing at least one of said first and second membership indicia" as recited in independent claim 12, and transferring the unique membership numbers to a portable handheld radio frequency identification (RFID) storage device using the storage device including a RF transponder and a database in communication with the transponder, the database containing a unique storage area for each unique membership number" as recited in claims 21 and 23.

21. In response to the Applicant's argument, the Examiner disagrees. In fact, the combined art disclose the system of registration for multiple suppliers and buyers. In Erickson's reference, the buyers and suppliers submit information i.e. profile and product information (registration) to a central database (as in a form of universal) ('644; Fig. 1; Abstract). Zalewski et al. discloses an electronic identification number and other information in response to the interrogation signal ('981; Fig. 11; Abstract), and the use of RFID with the profile database for communication between the user and suppliers ('981; Col. 17, lines 42-67), Further, Zalewski et al. discloses the reader such as a card verification authority ('981; Col. 10, lines 39-50; Col. 11, lines 51-67) and the response

and ID information sent to host to look up ID for transaction approval ('981; Col. 12, lines 21-43).

Therefore given the broadest reasonable interpretation to one of ordinary skill in the art, it is submitted that the system of registration for multiple suppliers and buyers as taught by Erickson, the use of RFID with the profile database for communication between the user and suppliers, ID information as taught by Zalewski et al. is in a form of an enrollment system, an unique storage area for each unique membership number as described in the Applicant's invention.

Therefore, the Examiner maintains the rejection to Applicant's claims

### ***Conclusion***

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HIEP NGUYEN whose telephone number is (571) 270-5211. The examiner can normally be reached on full.

25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on 5712726787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/H. N./  
Examiner, Art Unit 3686

/Gerald J. O'Connor/  
Supervisory Patent Examiner  
Group Art Unit 3686